

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Christine Carlucci and Gerard Carlucci

For: Medical Tubing Securing Device

Serial No.: 09/930,398

Filed: August 15, 2001

Group: 3761

Atty Docket: 262.801

Petition to Vacate Final Rejection

Director of the US Patent and Trademark Office
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

Applicants submit this petition, invoking the supervisory authority of the Director of the USPTO under 37 C.F.R. § 1.181, to vacate a final rejection as premature. The final rejection was mailed on July 11, 2006. On August 11, 2006, applicants submitted a request to the examiner for withdrawal of the final rejection and also requested that he reconsider the rejection in light of the comments submitted in that request. As of this date, the deadline for the filing of a petition to the Director, no response from the examiner has been received.

I. Statement of Facts

The procedural history and facts of this case are verified in the accompanying declaration of Marguerite Del Valle. This application was filed on August 15, 2001. A first office action rejecting the claims under § 102 in view of US Patent 6,269,814 to Blaszczykiewicz was mailed on October 29, 2002 to which a response was filed on January 28, 2003. A final rejection issued on April 9, 2003, rejecting the claims under § 103 in view of the Blaszczykiewicz patent, to which an appeal was taken and a brief filed on September 9, 2003. Del Valle Declaration, ¶¶ 1-4.

In view of the brief, the final rejection was withdrawn on November 28, 2003, and a further office action issued, this time rejecting the claims under § 102 in view of US Patent 5,411,484 to Shattuck, and under § 103 in view of the Shattuck patent taken with US Patent 3,878,849 to Muller. Applicants filed a response to that office action on February 25, 2004. A final rejection then issued on May 18, 2004, rejecting the claims under § 102 in view of the Shattuck patent taken with a new reference, US Patent 5,154,690 to Shiono. Applicants filed an appeal brief on October 18, 2004. *Id.*, ¶¶ 5-7.

The examiner reopened prosecution on January 1, 2005, and issued a further office action, rejecting the claims under § 102 in view of the Shattuck patent, under § 102 in view of US Patent 4,723,325 to Perry, and under § 103 in view of the Shattuck patent taken with the Muller patent. Applicants responded on May 11, 2005. The examiner issued a final rejection on the claims on August 19, 2005, withdrawing the previous rejections and citing new grounds, US Patent 5,446,953 to LeFeber, to reject the claims under § 102. *Id.*, ¶¶ 8, 9.

Applicants filed a Request for Continuing Application on November 7, 2005, including a preliminary amendment. On January 20, 2006, the examiner rejected the claims again under the LeFeber patent. Applicants responded to the office action on April 12, 2006. On July 11, 2006, the examiner issued the present final office action, rejecting the claims on new grounds, US Patent 5,117,510 to Broussard. The Broussard patent, however, had been included by the applicants in an information disclosure statement, filed on November 11, 2001. The examiner had never applied it to the claims at issue, thus the applicants never had an opportunity to point out the patentability of the claims over the Broussard patent. *Id.*, ¶¶ 10-12.

Applicants filed a request for withdrawal of the final rejection as premature and requested that the examiner reconsider the rejection in view of the comments submitted. The examiner has not yet acted on applicants' request. *Id.*, ¶ 13.

II. The Final Rejection Was Premature in that the Examiner Introduced a New Ground of Rejection that Was Neither Necessitated by Applicant's Amendment Nor Based on Information Submitted in an Information Disclosure Statement Filed Pursuant to 37 CFR 1.97(c)

It is well established that "[b]efore a final rejection is in order, a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy a conclusion as possible and at the same time to deal justly by the both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the *references fully applied*. . . . Switching from ... one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will ... tend to defeat attaining the goal of reaching a clearly defined issue." MPEP 706.07 (emphasis supplied).

In this case, after substantial and protracted examination spanning five years, including the preparation and submission by applicants of two appeal briefs which caused the examiner to withdraw the final rejections to which they were drawn, the examiner finally rejected the claims on new grounds, specifically under § 102 as anticipated by US Patent 5,117,510 to Broussard. This latest determination of finality was premature because the applicants were not given an opportunity to address this reference so that the issues could be clearly defined.

As advised in MPEP 706.07(a), a final rejection on new grounds is not proper unless the new ground is necessitated by applicant's amendment of the claims or is based on information submitted in an information disclosure statement filed pursuant to 37 CFR § 1.97(c).

The applicants made the Broussard patent of record in an information disclosure statement filed on November 15, 2001, almost one year before the first of eight office actions issued in this case. The examiner, however, never applied the this patent to the claims until July 11, 2006.

The examiner's statement that the new grounds of rejection were necessitated by applicants' amendment is not well taken. Applicants' amendment on April 12, 2006 expressly limited claim 1 to a band composed of no more than two layers of fabric anywhere along the length. The Broussard patent does not teach or suggest any limitation regarding the number of layers of fabrics to use to practice the invention disclosed in the patent.

The claims as amended in April 2006 are to substantially the same subject matter as what had been originally filed in August 2001. The Broussard patent should have been applied to the claims during prosecution so that applicants would have had a fair chance to address it. Instead, the Broussard patent was cited against the claims in a paper that closed prosecution. The applicants are therefor denied just treatment in that they are precluded from addressing a reference that they have made of record but which has never been raised as a ground to deny patentability.

III. Action Requested

It is respectfully submitted that applicants' claims have been thoroughly examined. It is unfair to applicants to further the prosecution. The claims are clearly patentable over the art cited. Applicants request that the final rejection be vacated in order to comport with the goals of the patent system; that prosecution be reopened in this case to fully consider the comments presented in the applicants' request, submitted on August 11, 2006; and that the claims be found to present patentable subject matter and be allowed in an expeditious manner.

September 11, 2006

/ Marguerite Del Valle /
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